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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|--------------------------|----------------------------|------------------|
| 10/720,206 | 11/25/2003 | William Hallen Falls JR. | MR1035-1346 | 4075 |
| 4586 | 7590 | 01/25/2006 | EXAMINER | |
| ROSENBERG, KLEIN & LEE | | | DOSTER GREENE, DINNATIA JO | |
| 3458 ELLICOTT CENTER DRIVE-SUITE 101 | | | ART UNIT | PAPER NUMBER |
| ELLICOTT CITY, MD 21043 | | | 3743 | |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/720,206 | | FALLS ET AL. | |
| | Examiner | | Art Unit | |
| | Dinnatia Doster-Greene | | 3743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detail Action</u> . |

DETAILED ACTION

Response to Amendment

The amendment filed on November 4, 2005 has been entered. Examiner acknowledges that **claims 1-22** have been cancelled and **claims 23-37** have been added.

Response to Arguments

Applicant's arguments filed November 4, 2005 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Marshall (U.S. Patent No. 4,205,680). Marshall discloses a surgical towel (10) comprising a sheet of woven fabric comprising at least one stitched hem (Fig. 1 and col. 2) and a thread for stitching the hem (22). The at least one piece of x-ray detectable material (21) is attached to the fabric by the thread (22) (cols. 2-4). The x-ray detectable material protrudes from the hem (Figs. 1-2). The x-ray detectable material allows indication of the surgical towel upon x-ray and visually identifying the surgical towel as x-ray detectable (col. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 24-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of DeBusk (U.S. Patent No. 5,792,128). Marshall discloses all the features claimed except the thread being a different color than the fabric and the specific limitation of the x-ray detectable material. However, DeBusk also discloses a surgical towel (see "surgical towel" in line 43 of col.2). DeBusk comprises a sheet of woven fabric comprising at least one stitched hem (Figs.1-5), and at least one piece of x-ray detectable material enclosed in the hem (54 of Figs.1-5), the x-ray detectable material allowing indication of the surgical towel upon x-ray (see "can be identified through x-ray examination" in line 23 of col.6), wherein the x-ray detectable material comprises 60% BaSO₄ and 40% PVC (see "polyvinyl chloride filled with at least about

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60%...barium sulfate" in lines 30-32 of col.4), wherein the sheet of woven fabric comprises cotton, synthetic material or a combination of these (see "cotton... or... combination" in lines 1-2 of col.4), wherein the sheet of woven fabric is single-ply (see "single" in line 1 of abstract), wherein the x-ray detectable material comprising shaped, coded, numbered, or identifying characteristics to identify an x-rayed object as a surgical towel (see "elongated...thread" in line 3 of abstract, also see "flat narrow ribbon" in line 39 of col.4), further comprising having four edges (Figs.1-5), at least one hem stitched in at least one of the four edges (Figs.1-5), a thread for stitching the at least one hem (Figs.1-5), at least one piece of x-ray detectable material enclosed in one of the at least one hem (Figs.1-5).

Regarding the limitation of the thread being a different color than the fabric, in view of DeBusk, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to have the thread being a different color than the fabric, because Applicant's specification states that "can be a different color" and "can be the same color" (see lines 20-21 of page 5). Thus, in Applicant's specification, a different color is not critical. Furthermore, it would have been obvious to one to incorporate the x-ray detectable thread of Marshall into the surgical towel of Marshall for the purpose of being able to more easily detect the surgical towel.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinnatia Doster-Greene whose telephone number is 571-272-7143. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ddg


HSC Bennett
Supervisory Patent Examiner
Group 2700